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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,890

06/28/2006

Jason D. Bonk

59136US010

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32692

7590

09/17/2009

3M INNOVATIVE PROPERTIES COMPANY

PO BOX 33427

ST. PAUL, MN 55133-3427

EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

09/17/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/596,890	<b>Applicant(s)</b> BONK ET AL.	
	<b>Examiner</b> Rita J. Desai	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/24/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/17/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION*****Election/Restrictions***

Applicant's election of Group I in the reply filed on 8/24/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Just a statement that it is not a burdensome search is insufficient. See EP 104764. WO2005020999. The restriction is proper and is now made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-7, 10-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for R1 to be phenyl substituted by as given in claims 8 and 9, does not reasonably provide enablement for the various substituents as given generically claimed such as

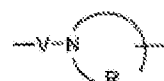
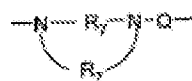
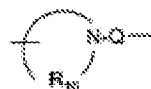
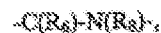
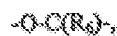
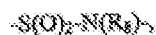
Ar is selected from the group consisting of aryl and heteroaryl both of which can be unsubstituted or can be substituted by one or more substituents independently selected from the group consisting of alkyl, alkoxy, haloalkyl, haloalkoxy, halogen, nitro, hydroxy, hydroxyalkyl, mercapto, cyano, carboxy, formyl, aryl, aryloxy, arylalkyleneoxy, heteroaryl, heteroaryloxy, heteroarylalkyleneoxy, heterocyclyl, heterocyclylalkylenyl, amino, alkylamino, and dialkylamino;

Ar' is selected from the group consisting of arylene and heteroarylene both of which can be unsubstituted or can be substituted by one or more substituents independently selected from the group consisting of alkyl, alkoxy, haloalkyl, haloalkoxy, halogen, nitro, hydroxy, hydroxyalkyl, mercapto, cyano, carboxy, formyl, aryl, aryloxy, arylalkyleneoxy, heteroaryl, heteroaryloxy, heteroarylalkyleneoxy, heterocyclyl, heterocyclylalkylenyl, amino, alkylamino, and dialkylamino;

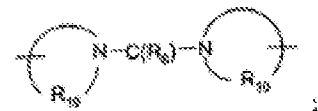
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X is selected from the group consisting of alkylene, alkenylene, alkynylene, arylene, heteroarylene, and heterocycliyene wherein the alkylene, alkenylene, and alkynylene groups can be optionally interrupted or terminated with arylene, heteroarylene, or heterocycliyene, and wherein the alkylene, alkenylene, and alkynylene groups can be optionally interrupted by one or more -O- groups;

Y is selected from the group consisting of



, and



. The

specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

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There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

**1) The breadth of the claims:** The instant claims encompass many zillions of compounds With various substitutions on the R1 phenyl as given above.

**2) The nature of the invention:** The invention is a pharmaceutical used to modulate cytokine biosynthesis.

**3) The state of the prior art:** The state of the prior art is that the drugs and the enzymes react in a lock and key mechanism and the structure of the compound has to be specific. Even a difference of a methyl group verses a hydrogen changes the properties altogether. A good example is a theophylline verses caffeine. They differ by just a methyl group but one of them has a pharmaceutical use as a bronchodilator. There is no absolute predictability and no established correlation between the different substitutions on a core that they would all behave in the exact same way. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

Also see Traci Testerman et al , Cytokine induction by immunomodulators imiquimod and S-27609, ( cited in the IDS) which shows that only a slight change (OH group/methyl group) can effect the activity.

How to make - As stated in the preface to a recent treatise:

"Most non-chemists would probably be horrified if they wereto learn how many attempted syntheses fail, and how inefficient research chemists are. The ratio of successful to unsuccessful chemical experiments in a normal research laboratory is far below unity, and synthetic research chemists, in the same way as most scientists, spend most of their time working out what went wrong, and why. Despite the many pitfalls lurking in organic synthesis, most organic chemistry textbooks and research articles do give the impression that organic reactions just proceed smoothly and that the total synthesis of complex natural products, for instance, is maybe a labor-intensive but otherwise undemanding task. In fact, most syntheses of structurally complex

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natural products are the result of several years of hard work by a team of chemists, with almost every step requiring careful optimization. The final synthesis usually looks quite different from that originally planned, because of unexpected difficulties encountered in the initially chosen synthetic sequence. Only the seasoned practitioner who has experienced for himself the many failures and frustrations which the development (sometimes even the repetition) of a synthesis usually implies will be able to appraise such work .....Chemists tend not to publish negative results, because these are, as opposed to positive results, never definite (and far too copious) ..... " Dorwald F. A.

Side Reactions in Organic Synthesis, 2005, Wiley: VCH, Weinheim pg. IX of Preface.

**4) The level of one of ordinary skill:** The ordinary artisan is highly skilled.

**5) The level of predictability in the art:**

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In *re Fisher*, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. The level of unpredictability in the art is very high. The compounds which differ by a methyl group also show different properties, for e.g. theophylline and caffeine. One of them is a bronchodilator and they differ only by a methyl group.

Also according to Dorwald it is very difficult to synthesize compounds. The various starting materials also need to be provided.

**6) The amount of direction provided by the inventor:** The inventor provides very little direction in the instant specification. There are no examples with the various substitutions for the different classes of the Markush substitutions and also there is no data provided to show that these compounds do indeed modulate cytokine biosynthesis.

**7) The existence of working examples:** The instant specification does not have any working examples for the large scope of how to make or how to use.

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**8) The quantity of experimentation needed to make or use the invention based on the content of the disclosure:** Since there are no working examples, the amount of experimentation is very high and burdensome for one to make and use the compounds as claimed.

Taking the above eight factors into consideration, it is not seen where the instant specification enables the ordinary artisan to make and/or use the instantly claimed invention.

Genetech Inc Vs Nova Nordisk 42 USPQ 2d 1001.

“A patent is not a hunting license. It is not a reward for search but compensation for its successful conclusion and patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable.”

MPEP 2164.01(a) states, "A conclusion of lack of enablement means that,

based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here. Thus, undue experimentation will be required to practice Applicants' invention.

### ***Claim Rejections - 35 USC § 103***

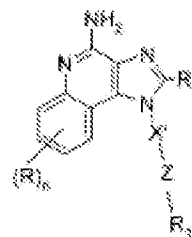
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 20030212092 ( US 6677348) Phillip Heppner et al and US 20020173655 (6664264) and 6670372. Dellaria Joseph et al, Gerster EP 145340, US 4688338, WO 9215582, US 5389640, 7038051 Kato Hideo et al, JP 11080156

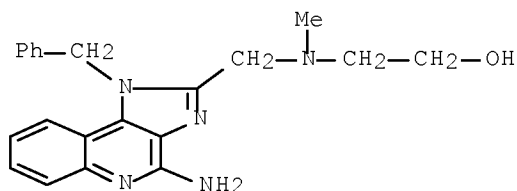
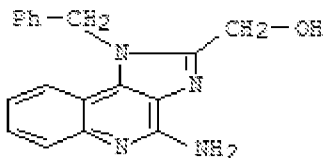


Applicants claims are drawn to compounds of the formula

wherein Z is an unsaturated  $-CH=CH-$  or a C triple bond C linkaged group.

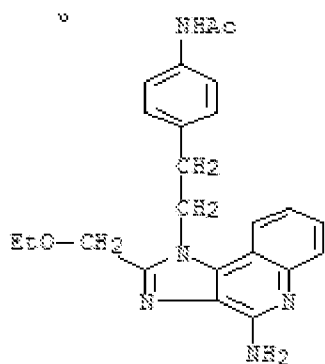
#### *Scope & Content of Prior Art MPEP 2141.01*

Gerster EP 145340, US 4688338, WO 9215582, US 5389640 , 7038051 and Kato et al all disclose compounds with the same core and R1 as a phenyl group. The difference is in the absence of the Z ( unsaturated linker) between the N of the imidazole and the phenyl R1.





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Gerster 7038051 teaches the equivalency of different linkages at the same position as the Z, the thio, linkage, amide , urea linkages. too.

US 20030212092 ( US 6677348) Phillip Heppner et al and US 20020173655 (6664264). Dellaria Joseph et al and 6670372 claim11, also disclose similar compounds for the same use but these do have a -CH=CH- or a C triplebond C group in the linkage.

*Difference between Prior Art and the claims MPEP 2141.02*

The difference between Gerster et al and Kato et al compounds is the presence of the unsaturated linkage.

*Prima Facie Obviousness , Rational and Motivation MPEP 2142-2413*

The deficiency in the Gerster et al., Kato et al compounds is overcome by the teachings in the Heppner et al and Dellaria et al references, which teach the same core compounds with the same utility. Thus motivating a person of skill in the art to have an unsaturated linkage on the Gerster et al and Kato et al compounds to obtain the compounds of the invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-13 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 formula II of copending Application No. 11/570707 in view of Gerster et al and Kato et al references. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims have the same core with the unsaturated link Z, motivating a person of skill in the art to modify the Gerster and the Kato Hideo et al compounds to have the unsaturated linkage. This is a provisional obviousness-type double patenting rejection.

Claims 2-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6670372 in view of Gerster and Kato references. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims have the same core with the unsaturated link Z,

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motivating a person of skill in the art to modify the Gerster and the Kato Hideo et al compounds to have the unsaturated linkage.

### ***Conclusion***

Claims 2-13 stand rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/  
Primary Examiner, Art Unit 1625

September 11, 2009